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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/595,322

04/07/2006

Andreas Koster

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EXAMINER

HO, HA DINH

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/595,322	Applicant(s) KOSTER ET AL.	
	Examiner HA D. HO	Art Unit 3681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/7/06, 7/26/06, 11/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is the first Office Action on the merits of Application No. 10/595,322 filed on 04/07/06. Claims 1-3 are currently pending.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because of using the implied phrase, i.e., "[t]he invention relates" (line 1), "[a]ccording to the invention" (line 3), and "[t]he invention embodiment enables" (line 6). Correction is required. See MPEP § 608.01(b).

Claim Objections

4. Claims 1 and 3 are objected to because of the following informalities:
 - Claim 1, line 12, "which" should be changed to --wherein the--.

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- Claim 3, line 3, “internal” (first occurrence) should be changed to --internally toothed--, and “internal” (second occurrence) should be deleted because claim 1 recites “an internally toothed gear or gear segment” in line 10.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3 recites “said axle is supported in said housing on a side opposite said motor end shield, and said internal gear or internal gear segment comprises a corresponding recess for said axle.” As understood, the axle 18 is supported by the motor end shield 9 and the cover 4 (which is the housing on a side opposite the motor end shield), the internal gear or internal gear segment 21 is arranged between the motor end shield 9 and the cover 4, and the axle 18 extends through the internal gear or internal gear segment 21. It is unclear of the structure of the internal gear or internal gear segment to make it possible to rotate 360° about the axis of the output shaft 22 while it would not be obstructed by the axle 18.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lang et al (US 6,007,446).

Lang et al teaches an actuating device (see Fig. 3) comprising a drive unit comprising an electric motor 8, which motor is arranged in a housing 1 and drives a drive shaft (i.e., the shaft that has the sun gear 21 mounted on); a gear unit comprising a drive gear 21 arranged on the drive shaft at least in a rotationally fixed manner, one or more planetary gears (23, 32), each planetary gear comprising a double gear having a larger gear wheel 23 and a smaller gear wheel 32 supported on an axle 29 in a fixed position and so that the planetary gear can pivot, and an internally toothed gear or gear segment 36 that is arranged on an output shaft 50 in an at least rotationally fixed manner, wherein the drive gear 21 in a first gear stage meshes with at least one planetary gear 23, whereby the drive gear 21 drives the larger gear wheel 23 of the double gear, and the smaller gear wheel 32, which faces a direction of an output side, in a second gear stage meshes with the internally toothed gear or gear segment 36, so that the output shaft 50 can be driven via the two gear stages; and a cover 2 fixed to the housing 1 of the drive unit and the outside of the gear unit, and arranged so that a bearing of the output shaft is arranged in the cover (note the extension 41 is supported in a bearing shell 43, which is an extension of the housing upper-piece 2, see col. 3, lines 8-9).

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9. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Misic (US 2,499,928).

Misic teaches an actuating device (see Fig. 2) comprising a drive unit comprising an electric motor (28, 38), which motor is arranged in a housing 10 and drives a drive shaft 60; a gear unit comprising a drive gear 62 arranged on the drive shaft 60 at least in a rotationally fixed manner, one or more planetary gears (79, 80), each planetary gear comprising a double gear having a larger gear wheel 79 and a smaller gear wheel 80 supported on an axle 76 in a fixed position and so that the planetary gear can pivot, and an internally toothed gear or gear segment 72 (note gear segment is defined as in axial direction) that is arranged on an output shaft 67 in an at least rotationally fixed manner, wherein the drive gear 62 in a first gear stage meshes with at least one planetary gear 79, whereby the drive gear 62 drives the larger gear wheel 79 of the double gear, and the smaller gear wheel 80, which faces a direction of an output side, in a second gear stage meshes with the internally toothed gear or gear segment 72, so that the output shaft 67 can be driven via the two gear stages; and a cover 63 fixed to the housing 10 of the drive unit and the outside of the gear unit, and arranged so that a bearing 66 of the output shaft 67 is arranged in the cover.

Regarding claim 2, wherein said at least one planetary gear (79, 80) of said gear unit features only one planetary gear, and further comprising a motor end shield 56 which supports said axle 76 of said planetary gear and to which said axle is fixed, and still further comprising a gear-side bearing 58 of said drive shaft 60 arranged in the shield 56, wherein the shield is arranged to be firmly connectable to said housing 10 of said electric motor.

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Cited Prior Art

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see the attached form PTO-892).

Communication

11. Submission of your response by facsimile transmission is encouraged. The fax phone numbers for the organization where this application or proceeding is assigned are **(571) 273-8300**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence not permitted by facsimile transmission, see M.P.E.P. 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check should not be submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P.. 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to
the Patent and Trademark Office on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P.. 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ha D. Ho whose telephone number is **571-272-7091**. If attempts

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to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor can be reached on **571-272-7095**.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/HDH/
(571) 272-7091
June 14, 2008

/Ha D. Ho/
Primary Examiner, A.U. 3681